

PATENT  
Docket NCR-8778

REMARKS

Reconsideration of the above identified application is respectfully requested.

Claims 22-30, starting with the second numbered claim 22, have been canceled, without prejudice, in view of the incorrect numbering thereof. Claims 31-39 have been added to replace those canceled claims on a one-to-one basis for a total of 31 claims.

And, the \$18 deficiency in fee for the 31st claim was authorized to be paid in Block 1 of the Fee Transmittal for FY 2002 submitted with the last amendment, and is hereby authorized to be paid from the identified deposit account (14-0225) in the event it has not yet been processed.

Applicant traverses the restriction requirement, and provisionally elects the Group IV claims, originally claims 22-30, and now claims 22 & 31-39.

Applicant traverses the examiner's contentions in para. 2 since the examiner's contention that "querying the user for seller input" is not a different process at all, let alone a materially different process. Both claims 1 and 8 recite substantially verbatim the same user input query, and the examiner's contention does not show otherwise, and is quite inconsistent with the features being claimed, see MPEP 806.05(e).

Regarding para. 3, the examiner's failure to afford due weight to express claim language is not supported by the MPEP or patent law, and the examiner has failed to show that the 1959 Danly case is relevant. Computer implemented claims require special evaluation by the examiner, as well explained in the MPEP, and Danly clearly predates modern analysis of computer-implemented claims.

The examiner's search contention in para. 4 is not relevant to restriction practice, and is incorrect as evidenced by the previous examination of the group I and II

PATENT  
Docket NCR-8778

claims. The references previously applied by the examiner have not been listed in the form PTO-892 as found in the search field identified in para. 1.

Accordingly, the examiner has failed to establish a basis to restrict under groups I and II, which restriction must be withdrawn.

The examiner's contention in para. 5 is erroneous: the groups I and III are both clearly combination claims, not subcombination claims, and the examiner's use of MPEP 806.05(d) is without merit.

Note that claims 1 and 15 recite related methods both of which result in the same output: displaying a filtered list of raw materials. The examiner's example of "market research tool" is clearly not excluded by these methods.

The examiner's contentions in para. 6 have not been supported by any evidence, and, to the contrary, the examiner's previous listing of field search in the PTO-892 is contra to the examiner's contention of search fields.

Accordingly, the examiner has failed to establish a basis to restrict under groups I and III, which restriction must be withdrawn.

The examiner's contentions in para. 7 are erroneous since the examiner has failed to show a materially different apparatus, or that the apparatus "does not require the equivalent of the corresponding structure of the means for populating."

The examiner has overlooked the populating means itself which provides filter lists for the customer application criteria for the raw materials.

In direct correspondence, claim 1 recites customer application criteria, raw material type, and selection based upon applying a filter.

It is quite incongruous for the examiner to contend the populating "means" element of claim 22 lacks an "equivalent" in claim 1, when it is notoriously common practice for the

PATENT  
Docket NCR-8778

USPTO to afford "means for" elements extraordinarily broad interpretation when rejecting claims over the art.

It is not seen how the common examination practice of broadly construing means elements, can be ignored for applying an unreasonably narrow interpretation solely for restriction practice, as the examiner has done.

The examiner's contentions in para. 8 have not been supported by any evidence, and, to the contrary, the examiner's previous listing of field search in the PTO-892 is contra to the examiner's contention of search fields.

Accordingly, the examiner has failed to establish a basis to restrict under groups I and IV, which restriction must be withdrawn.

The examiner's contentions in para. 9 regarding the group II and III claims is clearly erroneous, and lacks technical credibility. The rote recitation of "by hand using index cards and a pencil" in no way establishes even the possibility that the complex process elements of claim 15 could be practiced by hand in a materially different process.

How are the index cards and pencil to be used for the disparate process elements of claim 15? The examiner has not explained this, because it is inexplicable.

Perhaps the different raw materials are listed by pencil on an index card. Where then are the other elements of claim 15 in the examiner's bald contention?

How are filter lists populated with the same or different index cards, and the same or different pencil?

How is a "material browser" displayed with the index cards and pencil, and how are the filters and lists thereof displayed?

How is one of the filter lists selected using the index cards and pencil?

How is the list of raw materials **filtered** by the index cards and pencil?

And then, how is the filtered list displayed in "said

PATENT

Docket NCR-8778

browser" by the index cards and pencil?

The examiner's mere contention for restriction purposes is blatantly simplistic, erroneous, and lacking in merits by failing to address the multiplicity of elements recited in claim 15. Clearly, the examiner has failed to meet the MPEP requirements.

The examiner's contentions in para. 10 have not been supported by any evidence, and, to the contrary, the examiner's previous listing of field search in the PTO-892 is contra to the examiner's contention of search fields.

Nevertheless, Applicant has chosen to amend claim 15 to introduce the computer system, as similarly recited in claim 8, to further render moot the examiner's simplistic use of index cards.

Accordingly, the examiner has failed to establish a basis to restrict under groups II and III, which restriction must be withdrawn.

The examiner's contentions in para. 11 are clearly erroneous since both claims 8 and 22 are combination claims having similar performance in displaying a filtered list of raw materials or types. MPEP 806.05(c) is not relevant, and the examiner has not shown otherwise.

Furthermore, the examiner's narrow interpretation of the populating means is not supported by the MPEP, or by the notoriously common broad USPTO evaluation of means elements and their broad "equivalents."

And, the examiner's contention is erroneous. The populating means in claim 22 provides the filter lists for the customer application criteria for the different raw materials.

Correspondingly, claim 8 recites a computer system having a processor and memory which are inherently, if not expressly, configured to contain the customer application criteria, different raw material type, and associated filter.

On what evidentiary basis, or logical basis, does the examiner contend that claim 8 lacks "the equivalents of the

PATENT  
Docket NCR-8778

corresponding structure of the means for populating?"

The examiner's further contention in para. 11 that the "subcombination has separate utility such as a generic personal computer" does not appear to have any relevance whatsoever to claims 8 and 22, or to MPEP 806.05(c) and is blatantly inconsistent with the examiner's contention in para. 13 that the "method [of group IV] could be performed by hand using index cards and a pencil."

Which then is it: "generic personal computer" or "by hand using index cards and a pencil?"

The examiner's yet further contention in para. 11 that "generic personal computers could be used to keep a list of available raw materials that are purchasable readily on hand," is indicative of the examiner's failure to afford any weight, let alone, due weight to computer-implemented inventions having special examination requirements in the MPEP.

Is it the examiner's opinion that no "generic personal computer" is patentable, notwithstanding the specific software thereof since any and all types of software "could be used?" If so, this is clear legal error.

The MPEP, and case law, makes quite clear even generic personal computers are patentable when programmed to perform specific tasks. The examiner is apparently disregarding the "function" of computer operation (see para. 3) in an erroneous interpretation of the MPEP and case law to not only avoid the examination of the restricted claims, but, of course, to continue to reject claims, without due regard to the evidentiary requirements, MPEP requirements, and case law holdings.

The examiner's contentions in para. 12 have not been supported by any evidence, and, to the contrary, the examiner's previous listing of field search in the PTO-892 is contra to the examiner's contention of search fields.

Accordingly, the examiner has failed to establish a basis

PATENT  
Docket NCR-8778

to restrict under groups II and IV, which restriction must be withdrawn.

The examiner's contentions in para. 13 are clearly erroneous, and the examiner's mere contention that "the method could be performed by hand using index cards and a pencil" lacks credibility for the reasons presented above regarding para. 9.

Claim 22 has nevertheless been amended to add the computer feature, and render moot the examiner's mere contention of hand-processing.

And, it is noted that apparatus claim 22 is the means-for equivalent of method claim 15 under MPEP 809.03, and should be examiner together in the present application.

Accordingly, the examiner has failed to establish a basis to restrict under groups III and IV, which restriction must be withdrawn.

The examiner's four-way restriction requirement contains numerous errors, and is conspicuous in the overly simplistic and cursory evaluation of the applicable restriction requirements, with the examiner showing a predisposition to both narrow the number of claims for examination, and reject the claims without suitable evidentiary, or MPEP, or legal support; resorting to the citation of numerous cases without regard to evaluating the factual or legal basis of those cases.

The two office actions of record are already expansive, and set the pace for protracted prosecution in which inordinate time will be expended by the examiner and this attorney.

This attorney therefore requests the courtesy of cooperation of this examiner to identify allowable claims to bring this prosecution to an early termination, not a protracted late termination. The examiner clearly has the skill to uncover allowable subject matter, and to negotiate allowable claims meeting all requirements of the patent

PATENT  
Docket NCR-8778

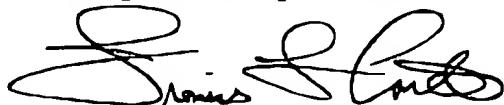
statutes.

Applicant's claimed invention clearly has fundamental differences over the references applied, and the examiner is requested to assist in placing the claims in condition for allowance, by suitable negotiation, if required.

Accordingly, should this, and the last amendment not place the claims in condition for allowance, the attorney hereby requests the examiner's further cooperation in scheduling a phone interview to address any remaining issues.

In view of the above remarks, withdrawal of the restriction requirement is requested, and allowance of all claims 1-22 and 31-39 over the art of record is warranted and is requested.

Respectfully submitted,



Date: 9 Jan 2003

Francis L. Conte  
Registration No. 29,630  
Attorney for Applicant  
Tel: 781-592-9077

NCR Corporation  
Law Department, WHQ-5E  
1700 S. Patterson Blvd.  
Dayton, OH 45479-0001  
Tel: 937-445-4956  
Fax: 937-445-3733

Appendix: pages 12 & 13

PATENT  
Docket NCR-8778

Appendix

Amended claims

15. (amended) A computer implemented method of selecting a raw material for manufacturing a product therefrom comprising:

    storing in a computer system a list of different raw materials, with each of said raw materials having various customer application criteria stored therewith, and said criteria being indicative of intended application of said raw material in a product;

    populating a plurality of filter lists corresponding with said stored customer application criteria for said different raw materials;

    displaying a material browser including a plurality of filters corresponding with said filter lists;

    selecting one of said filter lists and specifying a filter criterion therein;

    filtering said list of raw materials to obtain a filtered list thereof matching said filter criterion; and

    displaying in said browser said filtered list of raw materials matching said filter criterion.

22. (amended) An apparatus for selecting a raw material for manufacturing a product therefrom comprising:

    ①means for storing in a computer system a list of different raw materials, with each of said raw materials having various customer application criteria stored therewith, and said criteria being indicative of intended application of said raw material in a product;

    ②means for populating a plurality of filter lists corresponding with said stored customer application criteria for said different raw materials;

    ③means for displaying a material browser including a plurality of filters corresponding with said filter lists;

    ④means for selecting one of said filter lists and

**PATENT**

Docket NCR-8778

specifying a filter criterion therein;

(b) means for filtering said list of raw materials to obtain a filtered list thereof matching said filter criterion; and said displaying means being further configured for displaying in said browser said filtered list of raw materials matching said filter criterion.